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Attorney Docket No. GEMS8081.072

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application : Zettel et al.
of
Serial No. : 09/681,573
Filed : May 1, 2001
For : Method and System for Publishing Electronic Media to a
Document Management System in Various Publishing Formats
Independent of the Media Creation Application
Group Art No. : 2178
Examiner : Kyle R. Stork

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

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REPLY BRIEF RESPONSIVE TO EXAMINER'S ANSWER
MAILED AUGUST 23, 2006

Dear Sir:

This Reply Brief is being filed in response to the Examiner's Answer mailed May 19, 2006.

REPLY BRIEF

In the Examiner's Answer mailed August 23, 2006, the Examiner maintained the rejection of claims 1-29 and dismissed all of the arguments set forth by Appellant in the Appeal Brief. In response, Appellant will only address the comments made by the Examiner in the Answer and stands by its original Appeal Brief.

With regard to claim 1, in the Answer ¶ (10) **Response to Argument** regarding Appellant's argument that there is insufficient motivation or suggestion to combine the teachings of ATS with Bendik, the Examiner stated that "Bendik is not relied upon to teach converting a document from its original format to any other format." Examiner's Answer, Aug. 23, 2006, pg. 17. The Examiner then stated that "Bendik is merely relied upon to teach a document management system (DMS)" Id.

To show a motivation to combine, the Examiner stated that:

ATS fails to teach a DMS. Bendik teaches a DMS (paragraphs 0007-0013). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined ATS publication with Bendik's DMS, since it would have allowed a user to use the advantages of a DMS, namely, easily sharing documents within a workgroup without requiring knowledge of the DOS filename or the physical location of the document (Bendik: paragraph 0003).

Id. at 18. Appellant disagrees that the combination of ATS with Bendik would be obvious to one of ordinary skill in the art as the Examiner asserted.

ATS discloses that the user "will see a standard file dialog box" after the OK button is clicked to begin generating a PDF. ATS, pg. 5. Thereafter, ATS instructs the user to "navigate to the directory on the hard drive where you want your PDF file to be created, and give the PDF file a name." Id. In complete contrast, the Examiner asserts that it would be obvious to one skilled in the art to use a DMS such that knowledge of the DOS filename or the physical location of the document is not required.

Therefore, on the one hand, ATS teaches requiring a user to enter a DOS filename and specify the physical location where the PDF file is to be created. On the other hand, the Examiner asserted an advantage of the DMS as disclosed in Bendik allows the user to share documents without requiring knowledge of the DOS filename or the physical location of the document.

Appellant believes that the Examiner has not properly shown how it would be obvious to one skilled in the art to combine art that contains such opposite teachings. That is, Appellant believes that it would not be obvious to one skilled in the art to combine ATS, which requires

user entry of filename and location, with Bendik, which teaches “sharing of documents in workgroups without requiring knowledge of, for example, the DOS filename or physical location of a document.” Bendik, para. 0003.

The Examiner also stated that “the applicant argues that ATS fails to provide a choice of publication format, instead requiring conversion to a PDF. . . .” Examiner’s Answer, pg. 18. The Examiner then stated that, “[w]hile this may be accurate, the appellant’s claim limitation require [sic], ‘selecting a publication format via the publication enabler (claim 1, line 10.)’” Id. The Examiner asserted that, “[b]y allowing conversion to a PDF, the limitation of selecting a publication format via a publication enabler, which is only required to be capable of converting a data file into at least one publication format in response to a publication instruction is met.” Id. Appellant respectfully disagrees.

First, Appellant points out that the Examiner asserted that pages 23-24 of ATS discloses the element of selecting a publication format via the publication enabler. As the Appellant explained in the Appeal Brief, filed October 18, 2006, pages 23-24 of ATS disclose an appendix entitled “PDF Forms on the Web” that briefly describes what a PDF form is, fields available for use on the PDF form for gathering information, and differences between HTML and PDF forms. Appeal Brief, Oct. 18, 2006, pg. 10. The Appellant also explained that ATS does not teach creating a PDF form via Adobe PDFWriter. Id. at 11.

Next, the Examiner asserted that initializing a publication enabler capable of converting a data file into at least one publication format in response to the publication instruction, as called for in claim 1, “requires that at least one publication format be presented.” Examiner’s Answer, pg. 18. Appellant respectfully disagrees. While it is envisioned that an embodiment of the invention includes presenting publication formats to a user, it is not “required” that a publication format be presented. That is, initializing a publication enabler capable of converting a data file into at least one publication format in response to the publication instruction does not require presenting a publication format.

The Examiner asserted that selecting a publication format via a publication enabler is met by allowing conversion to a PDF, as stated above. However, allowing conversion to a PDF when the PDF format is not selected via the publication enabler does not teach or suggest selecting a publication format via the publication enabler. ATS fails to teach or even suggest selecting the PDF format via a publication enabler.

Accordingly, Appellant believes that the Examiner has not sufficiently satisfied the burden to show a *prima facie* case of obviousness with regard to claim 1.

With regard to claim 5, the Examiner stated that “[t]he examiner acknowledges that ATS does not disclose providing the parameters to the DMS, however, Bendik further discloses the method wherein a document management system receives a plurality of parameters used to automatically assign a file a coded filename, a storage location, and a file identifier” Examiner’s Answer, pg. 19. As explained above, ATS teaches that the user navigates to the directory where the file will be created and gives the file a name. In contrast, Bendik teaches “sharing of documents in workgroups without requiring knowledge of, for example, the DOS filename or physical location of a document.” Bendik, para. 0003. Accordingly, it would not be obvious to one skilled in the art to combine ATS with Bendik.

Further, claim 5 calls for, in part, transmitting the data file to the document management system. That is, the accessed data file, from which the data file in at least one publication format is published, is itself transmitted to the DMS. The Examiner has not shown where the art of record teaches or suggests transmitting the data file to the DMS. ATS discloses saving the converted PDF document to a location specified by a user, but ATS is silent on the accessed data file from which the PDF is created.

Accordingly, Appellant believes that the Examiner has not sufficiently satisfied the burden to show a *prima facie* case of obviousness with regard to claim 5.

With regard to claims 8 and 25, the Examiner stated that “the appellant presents arguments similar to those presented with respect to claim 1.” Examiner’s Answer, pg. 19. To the extent that the remarks set forth above with regard to claim 1 apply to claims 8 and 25, Appellant incorporates such remarks with regard to claims 8 and 25.

With regard to claims 12 and 16, Appellant incorporates the remarks set forth above regarding a lack of motivation to combine ATS with Bendik. Appellant further believes that it would not be obvious to one skilled in the art “to have combined ATS and Bendik with Alam, since it would have allowed a user to generate multiple documents for several applications.” Examiner’s Answer, pg. 20.

As explained in the Appeal Brief, Alam discloses Adobe PDF document generation applications for producing a PDF document. Appeal Brief, Oct. 18, 2006, pg. 16. Appellant further explained, “One skilled in the art would recognize that the “ACROBAT WRITER” application software of Alam performs the functions of the “Acrobat PDFWriter” application software as disclosed in ATS.” Id. at 16-17. Since both Alam and ATS disclose PDF writer application software for generating PDF files, Appellant believes that one skilled in the art would not be motivated to combine Alam with ATS for allowing a user to generate multiple documents

for several applications because Alam does not need the teachings of ATS for PDF document generation.

Next, the Examiner stated that “the applicant argues that the combination of ATS, Bendik, and Alam fail to teach . . . conversion of an electronic data file into at least two of a number of publication formats (pages 17-18).” Examiner’s Answer, pg. 20. However, the Appellant did not argue that the combination of ATS, Bendik, and Alam fail to teach conversion of an electronic data file into at least two of a number of publication formats. Instead, Appellant argued:

Notwithstanding that claim 16 does not call for a converter configured to substantially simultaneously convert the electronic data file into at least two of a number of publication formats, Alam also fails to teach or suggest a converter configured to convert the electronic data file and teach or suggest at least one publication system capable of publishing the converted data file all as called for in claim 16.

Appeal Brief, Oct. 18, 2006, pg. 18. Claim 16 does not call for a converter configured to convert the electronic data file directly into at least two of a number of publication formats compatible with a document management system

Accordingly, Appellant believes that the Examiner has not sufficiently satisfied the burden to show a *prima facie* case of obviousness with regard to claims 12 and 16.

With regard to claim 26, the Examiner stated that “Chen creates a new STG file for each new document (column 4, lines 9-11).” Id. at 22. The Examiner also stated that “the STG file contains a data field including a file name (column 4, lines 22-27).” Id.

Chen teaches that an “STG file 200 may include a data field 205 which contains a file name, e.g., “001.STG”, to identify the corresponding STG file 200.” Col. 4, lns. 22-24. However, claim 26 calls for, in part, automatically generation of a document management system document identifier and assignment of the document management system document identifier to the document. The Examiner has not shown, and the art of record fails to teach, that the data field including the file name automatically generates the file name and assigns the file name to the document. Further, the STS file name is not assigned to the corresponding document. That is, Chen fails to teach or suggest that an automatically generated document management system document identifier is assigned to the document that a user desires to publish. Instead, the file name pertains to the STG file.

Accordingly, Appellant believes that the Examiner has not sufficiently satisfied the burden to show a *prima facie* case of obviousness with regard to claim 26.

With regard to claim 28, the Examiner stated that “the appellant presents arguments similar to those presented with respect to claim 24.” Examiner’s Answer, pg. 22. To the extent that the remarks set forth above with regard to claim 24 apply to claim 28, Appellant incorporates such remarks with regard to claim 28.

In light of the foregoing remarks, Appellant respectfully submits that the Examiner has provided no supportable position that claims 1-29 are not patentable. Appellant believes that each claim is directed to statutory subject matter and defines over the art of record.

Respectfully submitted,

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